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I. STATUS OF CLAIMS

Claims 1-50 were pending at the time of the Office Action dated March 5, 2009.

Claims 1-50 stand rejected under 35 USC §101 as directed towards non-statutory subject matter. *See Office Action*, p. 4 (March 5, 2009).

Claims 1-6, 12-18, 21-31, 37-43, and 46-50 stand rejected under 35 USC §103(a) as being anticipated by Jaeger (US 6,345,028) in view of IEEE 100: The Authoritative Dictionary of IEEE Standards Terms, Seventh Edition ("IEEE"). *See Office Action*, p. 4 (March 5, 2009).

Claims 7-11, 19-20, 32-36, and 44-45 stand rejected under 35 USC §103(a) as being unpatentable over Jaeger in view of IEEE as applied above, and further in view of Yao et al. (US 5,938,734). *See Office Action*, p. 15 (March 5, 2009).

In addition, the Examiner objected to the disclosure as containing an embedded hyperlink.

Claims 1, 6, 7, 12, 15, 26, 31, 32, 37, and 40 are amended herein.

Claims 1-50 remain pending.

II. OBJECTION TO THE SPECIFICATION

The Office Action objected to the Abstract as containing an embedded hyperlink. The Abstract has been amended to remove the objected-to reference. Accordingly, applicant respectfully requests removal of the objection.

III. REJECTIONS NOT BASED ON CITED ART

Claims 1-50 stand rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. More specifically, claims 1-25 were rejected as being a process that is not tied to a particular machine or that does not transform a particular article to a different state or thing. Claim 1 as amended recites a hardware spatial data storage system. Accordingly, applicant respectfully requests removal of the rejection to claims 1-

25. Accordingly, Claim 1 is believed to be allowable for at least the reasons discussed herein.

Claims 26-50 were rejected as not being limited to tangible embodiments, as the specification (allegedly) recites the system can be embodied as entirely software, per se.

Applicant notes the specification (page 32, paragraph 1) recites:

In a general sense, those skilled in the art will recognize that the various embodiments described herein which can be implemented, individually and/or collectively, by a wide range of hardware, software, firmware, or any combination thereof can be viewed as being composed of various types of "electrical circuitry."

(Emphasis added.)

Accordingly, in light of the specification, it can be understood that a solely software implementation can be viewed as being composed of various types of "electrical circuitry," which are commonly viewed as being tangible. Therefore, claims 26-50 can be understood to be limited to a tangible embodiment such as a device comprising electrical circuitry." Accordingly, applicant respectfully requests removal of the rejection to claims 26-50. For at least for the reasons stated herein, the claims are respectfully submitted to be allowable.

IV. REJECTIONS UNDER §§102-103

As noted above in the section entitled "Interview Summary," Applicant respectfully submits that tentative agreement was reached that the proposed amendments of Applicant's representative claim 7 as contained in this Response will overcome the Examiner's current rejections for claim 7 and claims depending therefrom; however, the Examiner will need to conduct an additional search prior to expressing an opinion on the overall allowability of the proposed amended claims.

In view of the foregoing amendments, Applicant respectfully requests reconsideration and withdrawal of all pending claim rejections, and notice of allowance of same.

V. ISSUES TO BE REVIEWED

The issues in this response relate to whether the art of record establishes a *prima facie* case of unpatentability of Applicant's Claims 1-50. For reasons set forth elsewhere

herein, Applicant respectfully asserts that the art of record does not establish a *prima facie* case of unpatentability of any pending claim.¹ Accordingly, Applicant respectfully requests that Examiner hold all pending Claims 1-50 allowable for at least the reasons described herein, and issue a Notice of Allowance on same.

VI. ARGUMENT: ART OF RECORD DOES NOT ESTABLISH *PRIMA FACIE* CASE OF UNPATENTABILITY IN VIEW OF CITED ART OF RECORD

Applicant respectfully asserts herein that, under the MPEP and legal standards for patentability as set forth below, the art of record does not establish a *prima facie* case of the unpatentability of Applicant's claims at issue. Specifically, Applicant respectfully shows below that the art of record does not recite the text of Applicant's claims at issue, and hence fails to establish a *prima facie* case of unpatentability. Accordingly, Applicant respectfully requests that the Examiner withdraw the rejections and hold all claims to be allowable over the art of record.

A. MPEP Standards for Patentability²

The MPEP states as follows: "the examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability. If that burden is met, the burden of coming forward with evidence or argument shifts to the applicant. . . . If examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent." *MPEP* § 2107 (citing *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir.

¹ Irrespective of a desire to be cooperative, the ability of any patent practitioner to help the Examiner fulfill this burden on the record is tightly curtailed by pre- and post-issuance legal standards and by various ethical duties in tension. See, e.g., 37 C.F.R. § 10.83 ("A practitioner should represent a client zealously within the bounds of the law."); 37 C.F.R. § 10.84 ("[A] practitioner shall not intentionally ... [p]rejudice or damage a client during the course of a professional relationship, except as required under this [ethics] part."); and 37 C.F.R. § 10.76 ("A practitioner should represent a client competently."). For these and other reasons, this document notes instances in which the Examiner inadvertently did not follow the prescribed rules rather than seeking to interpret claims and/or to adduce evidence on the Examiner's behalf.

² Applicant is aware that Examiner is familiar with the MPEP standards. Applicant is merely setting forth the MPEP standards to serve as a framework for Applicant's arguments following and to ensure a complete written record is established. Should Examiner disagree with Applicant's characterization of the MPEP standards, Applicant respectfully requests correction.

1992)); *In re Glaug*, 283 F.3d 1335, 62 USPQ2d 1151 (Fed. Cir. 2002) (“During patent examination the PTO bears the initial burden of presenting a *prima facie* case of unpatentability. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). If the PTO fails to meet this burden, then the applicant is entitled to the patent.”). Accordingly, unless and until an examiner presents evidence establishing *prima facie* unpatentability, an applicant is entitled to a patent on all claims presented for examination.

1. MPEP Standards for Determining Anticipation

An examiner bears the initial burden of factually supporting any *prima facie* conclusion of anticipation. *Ex Parte Skinner*, 2 U.S.P.Q.2d 1788, 1788-89 (B.P.A.I. 1986); *In re King*, 801 F.2d 1324, 231 U.S.P.Q. (BNA) 136 (Fed. Cir. 1986); *MPEP* § 2107 (citing *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992) (“[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability....”). Failure of an examiner to meet this burden entitles an applicant to a patent. *Id.* (“[i]f examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent”).

The MPEP indicates that in order for an examiner to establish a *prima facie* case of anticipation of an applicant’s claim, the examiner must first interpret the claim,³ and thereafter show that the cited prior art discloses the same elements, in the same arrangement, as the elements of the claim which the examiner asserts is anticipated. More specifically, the MPEP states that “[a] claim is anticipated *only if each and every element as set forth in the claim is found*, either expressly or inherently described, in a single prior art reference. . . . The identical invention must be shown in as complete detail as is contained in the . . . claim. . . . The elements must be arranged as required by

³ With respect to interpreting a claim at issue, the MPEP directs that, during examination -- as opposed to subsequent to issue -- such claim be interpreted as broadly as the claim terms would reasonably allow, in light of the specification, when read by one skilled in the art with which the claimed invention is most closely connected. *MPEP* § 2111.

the claim". *MPEP* § 2131 (emphasis added). Consequently, under the guidelines of the MPEP set forth above, if there is *any* substantial difference between the prior art cited by an examiner and an applicant's claim which the examiner asserts is rendered anticipated by the prior art, the prior art does NOT establish a *prima facie* case of anticipation and, barring other rejections, the applicant is entitled to a patent on such claim.

2. MPEP Standards for Determining Obviousness

"[T]he examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness."⁴ *MPEP* § 2142. The MPEP indicates that in order for an examiner to establish a *prima facie* case that an invention, as defined by a claim at issue, is obvious, the examiner must (1) interpret the claim at issue; (2) define one or more prior art reference components relevant to the claim at issue; (3) ascertain the differences between the one or more prior art reference components and the elements of the claim at issue; and (4) adduce objective evidence which establishes, under a preponderance of the evidence standard, a teaching to modify the teachings of the prior art reference components such that the prior art reference components can be used to construct a device substantially equivalent to the claim at issue. This last step generally encompasses two sub-steps: (1) adducement of objective evidence teaching how to modify the prior art components to achieve the individual elements of the claim at issue; and (2) adducement of objective evidence teaching how to combine the modified individual components such that the claim at issue, as a whole, is achieved. *MPEP* § 2141; *MPEP* § 2143. Each of these forgoing elements is further defined within the MPEP. *Id.*

This requirement has been explained recently by the Supreme Court in *KSR v. Teleflex*, 550 U.S. ____; 127 S. Ct. 1727 (2007) which noted that such a rejection requires "some articulated reasoning ... to support the legal conclusion of obviousness." As stated by the Court, obviousness can be established where "there was an apparent

⁴ An invention, as embodied in the claims, is rendered obvious if an examiner concludes that although the claimed invention is not identically disclosed or described in a reference, the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. *MPEP* § 2141 (citing 35 U.S.C. § 103).

reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, *this analysis should be made explicit.*" (*emphasis added*) See In re Kahn, 441 F. 3d 977, 988 (CA Fed. 2006) ('[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.')."
KSR v. Teleflex, 550 U.S. ____; 127 S. Ct. 1727 at 1741.

As further described by the Court "*[A] patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.*" Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known."
KSR v. Teleflex, 550 U.S. ____; 127 S. Ct. 1727 at 1741.

a) Interpreting a Claim at Issue

With respect to interpreting a claim at issue, the MPEP directs that, during examination -- as opposed to subsequent to issue -- such claim be interpreted as broadly as the claim terms would reasonably allow when read by one skilled in the art with which the claimed invention is most closely connected. In practice, this is achieved by giving each of the terms in the claim the "plain meaning" of the terms as such would be understood by those having ordinary skill in the art, and if portions of the claim have no "plain meaning" within the art, or are ambiguous as used in a claim, then the examiner is to consult the specification for clarification. *MPEP* § 2111.

b) Definition of One or More Prior Art Reference Components Relevant to the Claim at Issue

Once the claim at issue has been properly interpreted, the next step is the definition of one or more prior art reference components (*e.g.*, electrical, mechanical, or other components set forth in a prior art reference) relevant to the properly interpreted claim at issue. With respect to the definition of one or more prior art reference components relevant to the claim at issue, the MPEP defines three proper sources of such prior art reference components, with the further requirement that each such source must have been extant at the time of invention to be considered relevant. These three sources are as follows: patents as defined by 35 U.S.C. § 102, printed publications as defined by 35 U.S.C. § 102, and information (*e.g.*, scientific principles) deemed to be "well known in the art"⁵ as defined under 35 U.S.C. § 102. *MPEP* § 2141; *MPEP* § 2144.

c) Ascertainment of Differences between Prior Art Reference Components and Claim at Issue; Teaching to Modify and/or Combine Prior Art Reference Components to Remedy Those Differences in Order to Achieve Recitations of Claim at Issue

With one or more prior art components so defined and drawn from the proper prior art sources, the differences between the one or more prior art reference components and the elements of the claim at issue are to be ascertained. Thereafter, in order to establish a case of *prima facie* obviousness, an examiner must set forth a rationale, supported by objective evidence⁶ sufficient to demonstrate under a preponderance of the evidence standard, that in

⁵ The fact that information deemed to be "well known in the art" can serve as a proper source of prior art reference components seems to open the door to subjectivity, but such is not the case. As a remedy to this potential problem, *MPEP* § 2144.03 states that if an examiner asserts that his position is derived from and/or is supported by a teaching or suggestion that is alleged to have been "well known in the art," and that if an applicant traverses such an assertion (that something was "well known within the art"), the examiner must cite a reference in support of his or her position. The same *MPEP* section also states that when a rejection is based on facts within the personal knowledge of an examiner, the data should be stated as specifically as possible, and the facts must be supported, when called for by the applicant, by an affidavit from the examiner. Such an affidavit is subject to contradiction or explanation by the affidavits of the applicant and other persons. *Id.* Thus, all sources of prior art reference components must be objectively verifiable.

⁶ The proper sources of the objective evidence supporting the rationale are the defined proper sources of prior art reference components, discussed above, with the addition of factually similar legal precedent. *MPEP* § 2144.

the prior art extant at the time of invention there was a teaching to modify and/or combine the one or more prior art reference components to construct a device practicably equivalent to the claim at issue.

The preferable evidence relied upon is an express teaching to modify/combine within the properly defined objectively verifiable sources of prior art. In the absence of such express teaching, an examiner may attempt to establish a rationale to support a finding of such teaching reasoned from, or based upon, express teachings taken from the defined proper sources of such evidence (*i.e.*, properly defined objectively verifiable sources of prior art). *MPEP* § 2144; *In re Dembiczak*, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999).

The MPEP recognizes the pitfalls associated with the tendency to subconsciously use impermissible "hindsight" when an examiner attempts to establish such a rationale. The MPEP has set forth at least two rules to ensure against the likelihood of such impermissible use of hindsight. The first rule is that:

under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information,⁷ the examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. Knowledge of an Applicant's disclosure must be put aside in reaching this determination, yet kept in mind in order to determine the "differences," conduct the search, and evaluate the "subject matter as a whole" of the invention. The tendency to resort to "hindsight" based upon an Applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

MPEP § 2142 (emphasis added). Thus, if the only objective evidence of such teaching to modify and/or combine prior art reference components is an applicant's disclosure, no evidence of such teaching exists.⁸

⁷ "Factual information" is information actually existing or occurring, as distinguished from mere supposition or opinion. *Black's Law Dictionary* 532 (5th ed. 1979).

⁸ An applicant may argue that an examiner's conclusion of obviousness is based on improper hindsight reasoning. However, "[a]ny judgment on obviousness is in a sense necessarily a reconstruction based on hindsight reasoning, but so long as it takes into account only knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made and does not include knowledge

The second rule is that if an examiner attempts to rely on some advantage or expected beneficial result that would have been produced by a modification and/or combination of the prior art reference components as evidence to support a rationale to establish such teachings to modify and/or combine prior art reference components, the MPEP requires that such advantage or expected beneficial result be objectively verifiable teachings present in the acceptable sources of prior art (or drawn from a convincing line of reasoning based on objectively verifiable established scientific principles or teachings). *MPEP* § 2144. Thus, as a guide to avoid the use of impermissible hindsight, these rules from the MPEP make clear that absent some objective evidence, sufficient to persuade under a preponderance of the evidence standard, no teaching of such modification and/or combination exists.⁹

cleaned only from applicant's disclosure, such a reconstruction is proper.” *MPEP* § 2145(X)(A) (emphasis added).

⁹ *In Re Sang Su Lee* 277 F.3d 1338 (Fed. Cir. 2002) (“When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness.”) *See, e.g., McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 U.S.P.Q.2d 1001, 1008 (Fed. Cir. 2001) (“the central question is whether there is reason to combine [the] references,” a question of fact drawing on the *Graham* factors). “The factual inquiry whether to combine references must be thorough and searching.” *Id.* It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. *See, e.g., Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 U.S.P.Q.2d 1456, 1459 (Fed. Cir. 2000) (“a showing of a suggestion, teaching, or motivation to combine the prior art references is an ‘essential component of an obviousness holding’”) (quoting *C.R. Bard, Inc., v. M3 Systems, Inc.*, 157 F.3d 1340, 1352, 48 U.S.P.Q.2d 1225, 1232 (Fed. Cir. 1998)); *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999) (“Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.”); *In re Dance*, 160 F.3d 1339, 1343, 48 U.S.P.Q.2d 1635, 1637 (Fed. Cir. 1998) (there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant); *In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988) (“‘teachings of references can be combined only if there is some suggestion or incentive to do so.’”) (emphasis in original) (quoting *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984)). The need for specificity pervades this authority. *See, e.g., In re Kotzab*, 217 F.3d 1365, 1371, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000) (“particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed”); *In re Rouffet*, 149 F.3d 1350, 1359, 47 U.S.P.Q.2d 1453, 1457-58 (Fed. Cir. 1998) (“even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious.”)).

B. Technical Material Cited by Examiner (Jaeger (US 6,345,028)) Does Not Show or Suggest the Text of Independent Claim 1 as Presented Herein; Notice of Allowance of Same Respectfully Requested

1. Independent Claim 1

Independent Claim 1 recites:

1. A method comprising:
 - [a] receiving a request for at least one specific content;
 - [b] obtaining one or more temporal addresses corresponding to the at least one specific content by associating the specific content with one or more times of one or more transmitted data portions, in response to the request for the at least one specific content; and
 - [c] selecting data from at least one data stream having spatial-to-temporal translated data, in response to the one or more temporal addresses, the spatial-to-temporal translated data being from a hardware spatial data storage system.¹⁰
- (Emphasis added.)

As shown following, (1) Examiner has ignored several express recitations of Independent Claim 1 in his analysis, (2) Examiner is interpreting Jaeger to “teach” at least a portion of the text of Independent Claim 1 but has not provided any objectively verifiable evidence supporting his interpretation, and (3) modifications/ combinations of technologies cited by Examiner to meet the recitations of Independent Claim 1 are mere conclusory statements, would change the principle of operation, and/or or render the prior art components unfit for their intended purpose.

Under the MPEP standards as set forth herein, Examiner has not met his burden to establish a prima facie case of the unpatentability of Independent Claim 1 for any or all of the forgoing reasons. Accordingly, Applicant respectfully requests that Examiner withdraw his rejections of Claim 1 and Issue a Notice of Allowability for same.

¹⁰ The lettering of the clauses herein is merely for sake of clarity of argument and should not be taken to imply any particular ordering of the clauses.

a) **Examiner Has Inadvertently Ignored Several Express Recitations of Independent Claim 56 and Therefore Has Not Met His Burden to Establish a *Prima Facie* Case of Unpatentability for Independent Claim 1.**

As set forth above, Independent Claim 1 recites as follows:

1. A method comprising:

[a] receiving a request for at least one specific content;

[b] obtaining one or more temporal addresses corresponding to the at least one specific content by associating the specific content with one or more times of one or more transmitted data portions, in response to the request for the at least one specific content; and

[c] selecting data from at least one data stream having spatial-to-temporal translated data, in response to the one or more temporal addresses, the spatial-to-temporal translated data being from a hardware spatial data storage system.
(Emphases added.)

Concerning this, Examiner has stated,

11. As per claim 1, Jaeger discloses a method comprising:

obtaining one or more temporal addresses corresponding to the at least one specific content (col. 5, lines 49-53, Fig. 1); *it should be noted that the "time stamps" are analogous to the "temporal addresses."*

and selecting data from at least one data stream having spatial to temporal translated data, in response to the one or more temporal addresses (col. 6, lines 49-53, Fig. 2). *It should be noted that the ordered addresses/data track signals being streamed from the RAM buffer are analogous to the "spatial-to-temporal translated data."*

Jaeger does not explicitly disclose receiving a request for at least one specific content.

IEEE discloses disk read I/O transactions are composed of transaction initiations (i.e. requests) (pg. 500, "I/O transaction" and pg. 1198, "transaction initiation (request)").

At the time of the invention it would have been obvious to a person of ordinary skill in the art to have the record/playback apparatus receive a playback request so that the incremental temporal segments of each recorded track are read from the disk in response to the playback request. The motivation for doing so would have been to prevent playback at times when the disk drive and/or RAM buffer are not ready to handle the reading and/or writing of data frames.

See Examiner's *Office Action*, p. 4-5 (March 5, 2009).

Claim 1 has been amended to include the limitations of claim 6. Concerning this, Examiner has stated:

16. As per claim 6, the combination of Jaeger/IEEE discloses obtaining one or more temporal addresses corresponding to the at least one specific content, in response to the request for the at least one specific content further comprises:

associating the specific content with one or more times of one or more

transmitted data portions (Jaeger, col. 5, lines 52-63, Fig. 1). It should be noted that the

"100 ms segments" are analogous to "one or more times."

See Examiner's *Office Action*, p. 6 (March 5, 2009).

As noted, Clause [b] of Independent Claim 1 recites "obtaining one or more temporal addresses corresponding to the at least one specific content by associating the specific content with one or more times of one or more transmitted data portions, in response to the request for the at least one specific content." (Emphasis added.) It appears to Applicant that a mapping "associating the specific content with one or more times of one or more transmitted data portion" onto "one or more times"¹¹ (see, Jaeger col. 5, lines 52-63) has not been explained how this mapping is reached under the broadest reasonable interpretation framework as is Examiner's burden (e.g., such as by examples drawn from Applicant's claims or detailed description),¹² and furthermore,

¹¹ An electronic search of Jaeger has shown the phrase "one or more times" does not appear in Jaeger.

¹² Irrespective of a desire to be cooperative, the ability of any patent practitioner to help the Examiner fulfill this burden on the record is tightly curtailed by pre- and post-issuance legal standards and by various ethical duties in tension. See, e.g., 37 C.F.R. § 10.83 ("A practitioner should represent a client zealously within the bounds of the law."); 37 C.F.R. § 10.84 ("[A] practitioner shall not intentionally ... [p]rejudice or damage a client during the course of a professional relationship, except as required under this [ethics]

Applicant points out that this mapping appears to disregard at least the “by associating the specific content with one or more times of one or more transmitted data portions.”

In view of the foregoing, Applicant points out that although Independent Claim 1 has been quoted in the present rejection, several claim terms have been disregarded in its analysis. Because Examiner ignored at least the foregoing bolded recitations of Independent Claim 1,¹³ under the MPEP guidelines as set forth above, the Examiner-cited technical material does not establish a *prima facie* case of the unpatentability of Independent Claim 1. For these reasons, Applicant respectfully asks Examiner to hold Independent Claim 1 allowable and to issue a Notice of Allowability of same.

b) Examiner is Characterizing Jaeger and/or IEEE to “Teach” the Text of Independent Claim 1, But Does Not Support His Characterization, Therefore The Examiner Has Not Met His Burden to Establish a *Prima Facie* Case of Unpatentability for Independent Claim 1

The Examiner has stated as follows:

11. **As per claim 1**, Jaeger discloses a method comprising:
obtaining one or more temporal addresses corresponding to the at least one specific content (col. 5, lines 49-53; Fig. 1). *It should be noted that the “time stamps” are analogous to the “temporal addresses.”*
and selecting data from at least one data stream having spatial to temporal translated data in response to the one or more temporal addresses (col. 6, lines 49-53; Fig. 2). *It should be noted that the ~~independent audio/video/data~~ tracks/signals being streamed from the RAM buffer are analogous to the “spatial-to-temporal translated data.”*

part.”); and 37 C.F.R. § 10.76 (“A practitioner should represent a client competently.”). For these and other reasons, this document notes instances in which the Examiner inadvertently did not follow the prescribed rules rather than seeking to interpret claims and/or to adduce evidence on the Examiner’s behalf.

¹³ Although Independent Claim 1 has been quoted in the present rejection, several claim terms have been disregarded in its analysis, as shown below.

Jaeger does not explicitly disclose receiving a request for at least one specific content.

IEEE discloses disk read I/O transactions are composed of transaction initiations (i.e. requests) (pg. 500, "I/O transaction" and pg. 1198, "transaction initiation (request)").

At the time of the invention it would have been obvious to a person of ordinary skill in the art to have the record/playback apparatus receive a playback request so that the incremental temporal segments of each recorded track are read from the disk in response to the playback request. The motivation for doing so would have been to prevent playback at times when the disk drive and/or RAM buffer are not ready to handle the reading and/or writing of data frames.

See Examiner's Office Action, p. 4-5 (March 5, 2009).

Claim 1 has been amended to include the limitations of claim 6. Concerning this, Examiner has stated:

16. As per claim 6, the combination of Jaeger/IEEE discloses obtaining one or more temporal addresses corresponding to the at least one specific content, in response to the request for the at least one specific content further comprises:

associating the specific content with one or more times of one or more transmitted data portions (Jaeger, col. 5, lines 52-63, Fig. 1). It should be noted that the "700 ms segments" are analogous to "one or more times."

See Examiner's Office Action, p. 6 (March 5, 2009).

Applicant respectfully disagrees and traverses the rejection.

(1) Examiner Has Put Forth No Evidence Supporting His Characterization That Jaeger "Teaches" Recitations of Independent Claim 1:

Applicant respectfully points out that Applicant has reviewed the portions of Jaeger identified by Examiner, and so far as Applicant can discern, Jaeger does not recite "obtaining one or more temporal addresses corresponding to the at least one specific content by associating the specific content with one or more times of one or more transmitted data portions, in response to the request for the at least one specific content" as recited in Applicant's Independent Claim 1. Rather, the portions of Jaeger cited by Examiner with respect to Claim 1 (as amended by Claim 6) recite as follows:

and ending with the last recorded track (e.g., track N). The temporal segments are all of the same short duration, such as 100 ms, although other durations may be used. In the example of FIG. 1, the first 100 ms segments of tracks 1–N are read in a predetermined order from the disk 11 and placed in a RAM buffer in the predetermined order, where they are assembled into composite data frame 1. Frame 1 is labeled with a time stamp which indicates the starting point of the frame and also the number of the frame. Likewise, the second 100 ms segments of tracks 1–N are then read from the disk drive 11 and placed in the RAM buffer as data frame 2, which is also labeled with its respective time stamp. This

See Jaeger (US 6,345,028, 5:52-63).

As can be seen from the foregoing, the Examiner-identified portions of Jaeger do not recite the text of at least clause [b] as recited in Independent Claim 1: “obtaining one or more temporal addresses corresponding to the at least one specific content by associating the specific content with one or more times of one or more transmitted data portions, in response to the request for the at least one specific content.” (Emphasis added.) Instead, Jaeger recites “First, incremental temporal segments of each recorded audio track are read from the disk 11 in a predetermined numerical order, e.g., starting with track 1 and ending with the last recorded track (e.g., track N). The temporal segments are all of the same short duration, such as 100 ms, although other durations may be used.” (Jaeger 5:49-54.) Consequently, on its face, Jaeger does not show the text of at least Clause [b] of Independent Claim 1.

Applicant respectfully notes: “[W]hat a reference teaches is a question of fact.” *Amazon.com, Inc. v. Barnesandnoble.com, Inc.*, 239 F.3d 1343, 1358 (Fed. Cir. 2001) (referencing *In re Beattie*, 974 F.2d 1309, 1311 (Fed.Cir.1992)). See also *McGinley v. Franklin Sports*, 262 F.3d 1339, 1350 (Fed. Cir. 2001).

Applicant respectfully submits that there is no PROFFERED EVIDENCE THAT WOULD SUPPORT A finding of fact that Jaeger describes or teaches the text of Clause [b] of Independent Claim 1. Under the guidelines from the *MPEP* and from the case law established by the Court of Appeals for the Federal Circuit, as set forth above, the cited art of record fails to suggest Independent Claim 1 for at least these reasons.

Applicant has shown by direct quotations that Independent Claim 1 and the Examiner-cited Jaeger reference are very different on their faces. *See supra* at pp. 26 (quotation of Claim 1); at pp. 30-31 (quotation of Jaeger). Insofar that Applicant has shown that “*at first sight; on the first appearance; on the face of it; so far as can be judged from the first disclosure*” the Examiner-cited art is very different from Claim 1, and Applicant has noted that Examiner has not cited to any objectively verifiable evidence/argument based on same sufficient to remedy such *prima facie* differences, the Examiner-cited technical material does not establish a *prima facie* case of the unpatentability of Claim 1 either under the MPEP or under controlling legal standards. *See supra* at pp. 20–25.

Accordingly, insofar as that Jaeger does not recite the text of at least Clause [b] of Applicant’s Independent Claim 1, and insofar as that Examiner has provided no objectively verifiable evidence, or argument based on objectively verifiable evidence, as to how Jaeger could be modified/combined to teach at least Clause [b] of Independent Claim 1, Applicant respectfully points out that under the MPEP guidelines as set forth above, the Examiner-cited technical material does not establish a *prima facie* case of the unpatentability of Independent Claim 1 for at least these reasons. Thus, Applicant respectfully asks Examiner to hold Independent Claim 1 allowable and to issue a Notice of Allowability of same.

With respect to Examiner assertions regarding the teachings of Jaeger, Applicant respectfully points out that even if Examiner’s assertions regarding the teachings of Jaeger were supported, such would be of no moment in that Examiner has yet to connect the alleged teaching of Jaeger to the actual express language of Applicant’s Independent Claim 1. Under the MPEP guidelines as set forth above, the cited art of record fails to establish a *prima facie* case of unpatentability for at least these reasons. Accordingly, for at least the foregoing reasons, Applicant respectfully requests that Examiner hold Independent Claim 1 allowable and issue a Notice of Allowability of same.

(2) Examiner Interpretation Appears to be Based on Inadvertent Impermissible Hindsight, Personal Knowledge, or Official Notice; Applicant Requests Issuance of Notice of Allowability

Given that Applicant has shown, above, what Jaeger actually recites, the question thus naturally arises as to how Examiner saw Jaeger as “teaching” something related to Clause [b] of Independent Claim 1. Applicant respectfully points out that the Applicant’s Application is the only objectively verifiable Examiner-cited document of record that shows or suggests what Examiner purports the references to teach. From this and the express recitations of Jaeger as set forth, it follows that Examiner is interpreting Jaeger through the lens of Applicant’s application, which is impermissible hindsight use. Thus, at present, Examiner’s assertions regarding Jaeger are untenable. Under the MPEP guidelines as set forth above, the cited art of record fails to establish a *prima facie* case¹⁴ of unpatentability for at least these reasons. Accordingly, for at least the foregoing reasons, Applicant respectfully requests that Examiner hold Independent Claim 1 allowable and issue a Notice of Allowability of same.

In the alternative and/or in addition to the foregoing, as Examiner has provided no objectively verifiable evidence, nor argument based on objectively verifiable evidence, in support of Examiner assertions regarding what the technical material cited by Examiner “teaches,” Applicant infers that the Examiner is relying on “personal knowledge” and/or is taking “official notice” of one or more factors to reach the factual conclusion of what the cited technical material “teaches.” In view of the foregoing, if Examiner desires to maintain the rejection, in the next communication, Applicant respectfully requests that the Examiner provide an affidavit or declaration setting forth objectively verifiable evidence in support of Examiner’s currently unsupported assertions regarding what the cited technical material “teaches” and/or should be interpreted to “teach.” See, e.g., MPEP S 2144.03(C), *If Applicant Challenges a Factual Assertion as Not Properly Officially Noticed or Not Properly Based Upon Common Knowledge, the Examiner Must Support the Finding with Adequate Evidence*, and 37 C.F.R. 1.104(d)(2).

¹⁴ Specifically, *prima facie* is defined as “at first sight; on the first appearance; on the face of it; so far as can be judged from the first disclosure.” *Black’s Law Dictionary* p. 1189 (6th ed. 1990).

(3) Examiner Has Put Forth No Evidence Supporting His Characterization That IEEE “Teaches” Recitations of Independent Claim 1:

Applicant respectfully points out that Applicant has reviewed the portions of IEEE identified by Examiner, and so far as Applicant can discern, IEEE does not recite “obtaining one or more temporal addresses corresponding to the at least one specific content by associating the specific content with one or more times of one or more transmitted data portions, in response to the request for the at least one specific content” as recited in Applicant’s Independent Claim 1. Rather, the portions of IEEE cited by Examiner with respect to Claim 1 (as amended by Claim 6) recite as follows:

I/O transaction An instance of activity between Functions, usually composed of an Initiation and a Completion, although not necessarily bound one to one. A disk read and network data delivery are examples of I/O transaction.
(C/NM) 1212.1-.993

See IEEE (page 590).

transaction initiation (request) A request generated by the initiator to start an action by the responder. An initiation message usually transfers a command and sometimes data. For a disk read I/O transaction, for example, the initiation transfers the address and command.
(C/NM) 1212.1-.993

See IEEE (page 1198).

As can be seen from the foregoing, the Examiner-identified portions of IEEE do not recite the text of at least clause [b] as recited in Independent Claim 1: “obtaining one or more temporal addresses corresponding to the at least one specific content by associating the specific content with one or more times of one or more transmitted data portions, in response to the request for the at least one specific content.” (Emphasis added.) Instead, IEEE recites “I/O transaction: An instance of activity between Functions, usually composed of an Initiation and a Completion, although not necessarily bound one to one. A disk read and network data delivery are examples of I/O transactions” and “transaction initiation (request) A request generated by the initiator to start an action by the responder. An initiation message usually transfers a command and sometime data. For a disk read I/O transaction, for example, the initiation transfers the address and command.” Consequently, on its face, IEEE does not show the text of at least Clause [b] of Independent Claim 1.

Applicant respectfully notes: “[W]hat a reference teaches is a question of fact.” *Amazon.com, Inc. v. Barnesandnoble.com, Inc.*, 239 F.3d 1343, 1358 (Fed. Cir. 2001) (referencing *In re Beattie*, 974 F.2d 1309, 1311 (Fed.Cir.1992)). See also *McGinley v. Franklin Sports*, 262 F.3d 1339, 1350 (Fed. Cir. 2001).

Applicant respectfully submits that there is no PROFFERED EVIDENCE THAT WOULD SUPPORT A finding of fact that IEEE describes or teaches the text of Clause [b] of Independent Claim 1. Under the guidelines from the *MPEP* and from the case law established by the Court of Appeals for the Federal Circuit, as set forth above, the cited art of record fails to suggest Independent Claim 1 for at least these reasons.

Applicant has shown by direct quotations that Independent Claim 1 and the Examiner-cited IEEE reference are very different on their faces. See *supra* at p. 26 (quotation of Claim 1); at p. 34 (quotation of IEEE). Insofar that Applicant has shown that “*at first sight; on the first appearance; on the face of it; so far as can be judged from the first disclosure*” the Examiner-cited art is very different from Claim 1, and Applicant has noted that Examiner has not cited to any objectively verifiable evidence/argument based on same sufficient to remedy such *prima facie* differences, the Examiner-cited technical material does not establish a *prima facie* case of the unpatentability of Claim 1 either under the *MPEP* or under controlling legal standards. See *supra* at pp. 20–25.

Accordingly, insofar as that IEEE does not recite the text of at least Clause [b] of Applicant's Independent Claim 1, and insofar as that Examiner has provided no objectively verifiable evidence, or argument based on objectively verifiable evidence, as to how IEEE could be modified/combined to teach at least Clause [b] of Independent Claim 1, Applicant respectfully points out that under the *MPEP* guidelines as set forth above, the Examiner-cited technical material does not establish a *prima facie* case of the unpatentability of Independent Claim 1 for at least these reasons. Thus, Applicant respectfully asks Examiner to hold Independent Claim 1 allowable and to issue a Notice of Allowability of same.

With respect to Examiner assertions regarding the teachings of IEEE, Applicant respectfully points out that even if Examiner's assertions regarding the teachings of IEEE were supported, such would be of no moment in that Examiner has yet to connect the

alleged teaching of IEEE to the actual express language of Applicant's Independent Claim 1. Under the MPEP guidelines as set forth above, the cited art of record fails to establish a *prima facie* case of unpatentability for at least these reasons. Accordingly, for at least the foregoing reasons, Applicant respectfully requests that Examiner hold Independent Claim 1 allowable and issue a Notice of Allowability of same.

(4) Examiner Interpretation Appears to be Based on Inadvertent Impermissible Hindsight, Personal Knowledge, or Official Notice; Applicant Requests Issuance of Notice of Allowability

Given that Applicant has shown, above, what IEEE actually recites, the question thus naturally arises as to how Examiner saw IEEE as “teaching” something related to Clause [b] of Independent Claim 1. Applicant respectfully points out that the Applicant's Application is the only objectively verifiable Examiner-cited document of record that shows or suggests what Examiner purports the references to teach. From this and the express recitations of IEEE as set forth, it follows that Examiner is interpreting IEEE through the lens of Applicant's application, which is impermissible hindsight use. Thus, at present, Examiner's assertions regarding IEEE are untenable. Under the MPEP guidelines as set forth above, the cited art of record fails to establish a *prima facie* case¹⁵ of unpatentability for at least these reasons. Accordingly, for at least the foregoing reasons, Applicant respectfully requests that Examiner hold Independent Claim 1 allowable and issue a Notice of Allowability of same.

In the alternative and/or in addition to the foregoing, as Examiner has provided no objectively verifiable evidence, nor argument based on objectively verifiable evidence, in support of Examiner assertions regarding what the technical material cited by Examiner “teaches,” Applicant infers that the Examiner is relying on “personal knowledge” and/or is taking “official notice” of one or more factors to reach the factual conclusion of what the cited technical material “teaches.” In view of the foregoing, if Examiner desires to maintain the rejection, in the next communication, Applicant respectfully requests that the Examiner provide an affidavit or declaration setting forth objectively verifiable

¹⁵ Specifically, *prima facie* is defined as “at first sight; on the first appearance; on the face of it; so far as can be judged from the first disclosure.” *Black's Law Dictionary* p. 1189 (6th ed. 1990).

evidence in support of Examiner's currently unsupported assertions regarding what the cited technical material "teaches" and/or should be interpreted to "teach." See, e.g., MPEP S 2144.03(C), *If Applicant Challenges a Factual Assertion as Not Properly Officially Noticed or Not Properly Based Upon Common Knowledge, the Examiner Must Support the Finding with Adequate Evidence*, and 37 C.F.R. 1.104(d)(2).

Applicant has reviewed the Examiner-cited portions of Jaeger and is unable to locate a recitation of clause [a] of Claim 1. Applicant further respectfully points out that the Examiner has provided no evidence or reason as to why the text of the reference passages should be interpreted to teach clause [a] of Independent Claim 1 as the Examiner alleges.

Given that Applicant has shown, above, what Jaeger actually recites, the question thus naturally arises as to how Examiner saw Jaeger as "teaching" something related to Clause [a] of Independent Claim 1. Applicant respectfully points out that the Applicant's Application is the only objectively verifiable examiner-cited document of record that shows or suggests what Examiner purports the reference to teach. From this and the express recitations of Jaeger as set forth, it follows that Examiner is interpreting Jaeger through the lens of Applicant's application, which is impermissible hindsight use. Thus, at present, Examiner's assertions regarding Jaeger are untenable. Under the MPEP guidelines as set forth above, the cited art of record fails to establish a prima facie case of unpatentability for at least these reasons. Accordingly, for at least the foregoing reasons, Applicant respectfully requests that Examiner hold Independent Claim 1 allowable and issue a Notice of Allowability of same.

In the alternative and/or in addition to the foregoing, as Examiner has provided no objectively verifiable evidence, nor argument based on objectively verifiable evidence, in support of Examiner assertions regarding what the technical material cited by Examiner "teaches," Applicant infers that the Examiner is relying on "personal knowledge" and/or is taking "official notice" of one or more factors to reach the factual conclusion of what the cited technical material "teaches." In view of the foregoing, if Examiner desires to maintain the rejection, in the next communication, Applicant respectfully requests that the Examiner provide an affidavit or declaration setting forth objectively verifiable evidence in support of Examiner's currently unsupported assertions regarding what the

cited technical material “teaches” and/or should be interpreted to “teach.” *See, e.g.,* MPEP S 2144.03(C), *If Applicant Challenges a Factual Assertion as Not Properly Officially Noticed or Not Properly Based Upon Common Knowledge, the Examiner Must Support the Finding with Adequate Evidence*, and 37 C.F.R. 1.104(d)(2).

In view of the foregoing, and under the MPEP standards as set forth above, Applicant respectfully submits that the Examiner-cited technical material does not establish a *prima facie* case of the unpatentability of Independent Claim 1. Accordingly, for at least the foregoing reasons, Applicant respectfully asks Examiner to hold amended Independent Claim 1 allowable and to issue a Notice of Allowance of same.

2. Dependent Claims 2-6, 12-18, and 21-25: Patentable for at Least Reasons of Dependency from Independent Claim 1.

Claims 2-6, 12-18, and 21-25 depend either directly or indirectly from Independent Claim 1. “A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.” *See* 35 U.S.C. § 112 paragraph 4. Consequently, Dependent Claims 2-6, 12-18, and 21-25 are patentable for at least the reasons why Independent Claim 1 is patentable. Accordingly, Applicant respectfully requests that Examiner hold Dependent Claims 2-6, 12-18, and 21-25 patentable for at least the foregoing reasons, and issue a Notice of Allowance on same.

C. Technical Material Cited by Examiner (Jaeger (US 6,345,028)) Does Not Show or Suggest the Text of Independent Claim 26 as Presented Herein; Notice of Allowance of Same Respectfully Requested

1. Independent Claim 26

Independent Claim 26 recites:

1. A method comprising:
 - [a] means for receiving a request for at least one specific content;
 - [b] means for obtaining one or more temporal addresses corresponding to the at least one specific content by associating the specific content with one or

more times of one or more transmitted data portions, in response to the request for the at least one specific content; and

[c] means for selecting data from at least one data stream having spatial-to-temporal translated data, in response to the one or more temporal addresses. (Emphasis added.)

As shown following, (1) Examiner has ignored several express recitations of Independent Claim 26 in his analysis, (2) Examiner is interpreting Jaeger to “teach” at least a portion of the text of Independent Claim 26 but has not provided any objectively verifiable evidence supporting his interpretation, and (3) modifications/ combinations of technologies cited by Examiner to meet the recitations of Independent Claim 26 are mere conclusory statements, would change the principle of operation, and/or render the prior art components unfit for their intended purpose.

Under the MPEP standards as set forth herein, Examiner has not met his burden to establish a prima facie case of the unpatentability of Independent Claim 26 for any or all of the forgoing reasons. Accordingly, Applicant respectfully requests that Examiner withdraw his rejections of Claim 26 and Issue a Notice of Allowability for same.

Concerning this, Examiner has stated,

29. As per claim 26, Jaeger discloses a system comprising:

means for obtaining one or more temporal addresses corresponding to the at least one specific content (col. 5, lines 52-63, Fig. 1); *See the citation note for the similar limitation in claim 1 above*

and means for selecting data from at least one data stream having spatial-to-temporal translated data, in response to the one or more temporal addresses (col. 6, lines 49-63; Fig. 2) *See the citation note for the similar limitation in claim 1 above.*

Jaeger does not explicitly disclose means for receiving a request for at least one specific content.

IEEE discloses disk read I/O transactions are composed of transaction initiations (i.e. requests) (pg. 590, "I/O transaction" and pg. 119B, "transaction initiation (request)").

At the time of the invention it would have been obvious to a person of ordinary skill in the art to have the record/playback apparatus receive a playback request so that the incremental temporal segments of each recorded track are read from the disk in response to the playback request. The motivation for doing so would have been to prevent playback at times when the disk drive and/or RAM buffer are not ready to handle the reading and/or writing of data frames.

See Examiner's Office Action, p. 9-10 (March 5, 2009).

Claim 26 has been amended to include the limitations of claim 31. Concerning this, Examiner has stated:

34. As per claim 31, the combination of Jaeger/IEEE discloses means for obtaining one or more temporal addresses corresponding to the at least one specific content, in response to the request for the at least one specific content further comprises:

means for associating the specific content with one or more times of one or more transmitted data portions (Jaeger, col. 5, lines 52-54, Fig. 1). *See the citation note for claim 6 above.*

See Examiner's Office Action, p. 11 (March 5, 2009).

Accordingly, the Examiner has rejected Independent Claim 26 for the same or similar reasons as Independent Claim 1. Thus the arguments presented above for Independent Claim 1 also similarly apply to Independent Claim 26. For the sake of brevity, the arguments are not repeated here (but are incorporated here by reference). In view of the foregoing, and under the 35 USC Section 103(a) statute, Applicant respectfully submits that the Examiner-cited art does not establish a *prima facie* case of unpatentability of Independent Claim 26. Accordingly, for at least the foregoing reasons, Applicant respectfully asks Examiner to hold Independent Claim 26 allowable and to issue a Notice of Allowance of same.

2. Dependent Claims 27-31, 37-43, and 46-50: Patentable for at Least Reasons of Dependency from Independent Claim 26.

Claims 27-31, 37-43, and 46-50 depend either directly or indirectly from Independent Claim 26. "A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers." *See* 35 U.S.C. § 112 paragraph 4. Consequently, Dependent Claims 27-31, 37-43, and 46-50 are patentable for at least the reasons why Independent Claim 26 is patentable. Accordingly, Applicant respectfully requests that Examiner hold Dependent Claims 27-31, 37-43, and 46-50 patentable for at least the foregoing reasons, and issue a Notice of Allowance on same.

D. Technical Material Cited by Examiner, Does Not Show or Suggest the Text of Claims 7-11 and 19-20 as Presented Herein; Notice of Allowance of Same Respectfully Requested

Claims 7-11 and 19-20¹⁶ depend either directly or indirectly from Independent Claim 1. "A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers." *See* 35 U.S.C. § 112 paragraph 4. Consequently, Dependent Claims 7-11 and 19-20 are patentable for at least the reasons why Independent Claim 1 is patentable. Accordingly, Applicant respectfully requests that Examiner hold Dependent Claims 7-11 and 19-20 patentable for at least the foregoing reasons, and issue a Notice of Allowability on same.

¹⁶ In relation to these dependent claims, Examiner has provided no objectively verifiable evidence, nor argument based on objectively verifiable evidence, in support of Examiner assertions regarding what the Jaeger and IEEE references "disclose." Insofar as none of these literally recite what Examiner asserts that they "disclose," Applicant respectfully asserts that Examiner must have relied on "personal knowledge" or taken improper "official notice" of one or more factors to reach each of these assertions. Applicant accordingly requests an appropriate affidavit or declaration in support of any of these rejections that are to be maintained, including any considerations purported to reflect what is "well known in the art." *See, e.g.,* 37 C.F.R. 1.104(d)(2).

1. Dependent Claim 7 is Independently Patentable

Irrespective of the arguments discussed above, Claim 7 is independently patentable.

With reference to Claim 7, Examiner has stated as follows:

48. As per claim 7, the combination of Jaeger/IEEE discloses all the limitations of claim 7 except said associating the specific content with one or more times of one or more transmitted data portions further comprises:

consulting a schedule having the specific content in association with the one or more times of the one or more transmitted data portions.

Yao discloses said associating the specific content with one or more times of one or more transmitted data portions further comprises:

consulting a schedule having the specific content in association with the one or more times of the one or more transmitted data portions (col. 7, lines 55-65, Fig. 5, element 26).

The combination of Jaeger/IEEE and Yao are analogous art because they are from the same field of endeavor, that being data streaming systems.

At the time of the invention it would have been obvious to a person of ordinary skill in the art to implement Yao's schedule within Jaeger/IEEE's recording/playback system. The motivation for doing so would have been to provide a real time stream server and a method for operating a real time stream server, capable of realizing a supply of a plurality of real time stream data with different data rates by a scheduling scheme using constant time-slot interval and transfer start timing period, without wasting a transfer capacity of disk devices (Yao, col. 2, lines 40-46).

See Examiner's Office Action, p. 15-16 (March 5, 2009).

Applicant respectfully points out that Applicant has reviewed the Jaeger/IEEE/Yao references identified by Examiner, and so far as Applicant can discern, the identified references do not recite “[b] the schedule being defined in response to an order in which the at least one content is spatially resident upon at least one hardware spatial data storage system” as required by amended claim 7. As discussed in the Examiner’s Interview of

August 27, 2009, Yao instead recites, “When a request for this real time stream data so stored in the disk devices is received from a client, stream recourses for as many unit streams as a recorded number of unit streams to be used for the requested real time stream data are secured (reserved), and a transfer start timing of each unit stream is scheduled so that the blocks are transferred continuously in an order as in the original real time stream data. At this point, the transfer start timings of the unit streams are scheduled to be displaced one another by a block transfer time part.” (Yao, 4:22-31.) Consequently, on its face, Yao does not show the text of Clause [b] of amended Claim 7.

Applicant has shown that on its face the evidence cited by Examiner does not establish a prima facie case of unpatentability with respect to Claim 7 or even to its parent claim. Applicant has shown by direct quotations that Applicant’s Claim 7 and the Examiner-cited Jaeger/IEEE/Yao references are very different on their faces. *See supra* at pp. 26 and 42 (quotation of Dependent Claim 7); at pp. 30 (quotation of Jaeger); at pp. 34 (quotation of IEEE); and at 43 (quotation of Yao). Insofar that Applicant has shown that “*at first sight; on the first appearance; on the face of it; so far as can be judged from the first disclosure*” the Examiner-cited art is very different from Dependent Claim 7 and its parent claim, and Applicant has noted that Examiner has not cited to any objectively verifiable evidence/argument based on same sufficient to remedy such *prima facie* differences, the Examiner-cited technical material does not establish a *prima facie* case of the unpatentability of Dependent Claim 7 and its parent claim either under the MPEP or under controlling legal standards. *See supra* at pp. **Error! Bookmark not defined.**–25.

E. Technical Material Cited by Examiner, Does Not Show or Suggest the Text of Claims 32-36 and 44-45 as Presented Herein; Notice of Allowance of Same Respectfully Requested

Claims 32-36 and 44-45 depend either directly or indirectly from Independent Claim 26. “A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.” *See* 35 U.S.C. § 112 paragraph 4. Consequently, Dependent Claims 32-36 and 44-45 are patentable for at least the reasons why Independent Claim 26 is patentable. Accordingly, Applicant

respectfully requests that Examiner hold Dependent Claims 32-36 and 44-45 patentable for at least the foregoing reasons, and issue a Notice of Allowability on same.

1. Dependent Claim 32 is Independently Patentable

Irrespective of the arguments discussed above, Claim 32 is independently patentable.

With reference to Claim 32, Examiner has stated as follows:

55. **As per claim 32**, the combination of Jaeger/EEE discloses all the limitations of claim 32 except said means for associating the specific content with one or more times of one or more transmitted data portions further comprises:

means for consulting a schedule having the specific content in association with the one or more times of the one or more transmitted data portions.

Yao discloses said means for associating the specific content with one or more times of one or more transmitted data portions further comprises:

means for consulting a schedule having the specific content in association with the one or more times of the one or more transmitted data portions (col. 7, lines 55-65, Fig. 5, element 26)

The combination of Jaeger/EEE and Yao are analogous art because they are from the same field of endeavor, that being data streaming systems.

At the time of the invention it would have been obvious to a person of ordinary skill in the art to implement Yao's schedule within Jaeger/EEE's recording/playback system. The motivation for doing so would have been to provide a real time stream server and a method for operating a real time stream server, capable of realizing a supply of a plurality of real time stream data with different data rates by a scheduling scheme using constant time-slot interval and transfer start timing period, without wasting a transfer capacity of disk devices (Yao, col. 2, lines 40-46).

See Examiner's Office Action, p. 17-18 (March 5, 2009).

Applicant respectfully points out that Applicant has reviewed the Jaeger/IEEE/Yao references identified by Examiner, and so far as Applicant can discern, the identified references do not recite “[b] the schedule being defined in response to an order in which the at least one content is spatially resident upon at least one hardware spatial data storage system” as required by amended claim 32. As discussed in the Examiner’s Interview of August 27, 2009, Yao instead recites, “When a request for this real time stream data so stored in the disk devices is received from a client, stream recourses for as many unit streams as a recorded number of unit streams to be used for the requested real time stream data are secured (reserved), and a transfer start timing of each unit stream is scheduled so that the blocks are transferred continuously in an order as in the original real time stream data. At this point, the transfer start timings of the unit streams are scheduled to be displaced one another by a block transfer time part.” (Yao, 4:22-31.) Consequently, on its face, Yao does not show the text of Clause [b] of amended Claim 32.

Applicant has shown that on its face the evidence cited by Examiner does not establish a prima facie case of unpatentability with respect to Claim 32 or even to its parent claim. Applicant has shown by direct quotations that Applicant’s Claim 32 and the Examiner-cited Jaeger/IEEE/Yao references are very different on their faces. *See supra* at p. 45 (quotation of Dependent Claim 32); at pp. 30 (quotation of Jaeger); at pp. 34 (quotation of IEEE); and at 45 (quotation of Yao). Insofar that Applicant has shown that “*at first sight; on the first appearance; on the face of it; so far as can be judged from the first disclosure*” the Examiner-cited art is very different from Dependent Claim 32 and its parent claim, and Applicant has noted that Examiner has not cited to any objectively verifiable evidence/argument based on same sufficient to remedy such *prima facie* differences, the Examiner-cited technical material does not establish a *prima facie* case of the unpatentability of Dependent Claim 32 and its parent claim either under the MPEP or under controlling legal standards. *See supra* at pp. **Error! Bookmark not defined.**–25.

VII. CONCLUSION

Applicant may have during the course of prosecution cancelled and/or amended one or more claims. Applicant notes that any such cancellations and/or amendments will

have transpired (i) prior to issuance and (ii) in the context of the rules that govern claim interpretation during prosecution before the United States Patent and Trademark Office (USPTO). Applicant notes that the rules that govern claim interpretation during prosecution form a radically different context than the rules that govern claim interpretation subsequent to a patent issuing. Accordingly, Applicant respectfully submits that any cancellations and/or amendments during the course of prosecution should be held to be tangential to and/or unrelated to patentability in the event that such cancellations and/or amendments are viewed in a post-issuance context under post-issuance claim interpretation rules.

Insofar as that the Applicant may have during the course of prosecution cancelled/amended claims sufficient to obtain a Notice of Allowability of all claims pending, Applicant may not have during the course of prosecution explicitly addressed all rejections and/or statements in Examiner's Office Actions. The fact that rejections and/or statements may not be explicitly addressed during the course of prosecution should NOT be taken as an admission of any sort, and Applicant hereby reserves any and all rights to contest such rejections and/or statements at a later time. Specifically, no waiver (legal, factual, or otherwise), implicit or explicit, is hereby intended (e.g., with respect to any facts of which Examiner took Official Notice, and/or for which Examiner has supplied no objective showing, Applicant hereby contests those facts and requests express documentary proof of such facts at such time at which such facts may become relevant). For example, although not expressly set forth during the course of prosecution, Applicant continues to assert all points of (e.g. caused by, resulting from, responsive to, etc.) any previous Office Action, and no waiver (legal, factual, or otherwise), implicit or explicit, is hereby intended. Specifically, insofar as that Applicant does not consider the cancelled/unamended claims to be unpatentable, Applicant hereby gives notice that it may intend to file and/or has filed a continuing application in order prosecute such cancelled/unamended claims. In addition, if the Board of Patent Appeals and Interferences determines that the Examiner has established a prima facie case, Applicant reserves the right to introduce substantive evidence to refute such prima facie case at a later time.

With respect to any cancelled claims, such cancelled claims were and continue to be a part of the original and/or present patent application(s). Applicant hereby reserves all rights to present any cancelled claim or claims for examination at a later time in this or another application. Applicant hereby gives public notice that any cancelled claims are still to be considered as present in all related patent application(s) (e.g. the original and/or present patent application) for all appropriate purposes (e.g., written description and/or enablement). Applicant does NOT intend to dedicate the subject matter of any cancelled claims to the public.

The Examiner is invited to contact Mark Hennings (360) 649-5566, or Dale R. Cook at (425)467-2260, with any issues that may advance prosecution of the application on the merits.

Respectfully submitted,

August 27, 2009
Date

/Mark Hennings, Reg. No. 48,982/
Mark R. Hennings
Registration No. 48,982